



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/813,636	03/21/2001	Gregory F. Borton	21024000110	3366

20350 7590 02/10/2005

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

NGUYEN, TAN D

ART UNIT	PAPER NUMBER
----------	--------------

3629

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/813,636

Applicant(s)

BORTON, GREGORY F.

Examiner

Tan Dean D. Nguyen

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
- Paper No(s)/Mail Date 2/23/01 & 4/8/02
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Information Disclosure Statement

The prior art statement filed 7/23/01 or 04/08/02 (same content) has been received and recorded.

Claim Objections

1. Claim 2 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It's not clear how this limitation further limits the steps (a)–(e) and the scope of the claim above.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. **Claims 1-6, 7-12, 13-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-6 (method), 7-12 (method), 13-17 (software to carryout the method) are directed to “A method for activity-based business modeling for an organization”, which is not within one of the classes of invention set forth in § 101.

Art Unit: 3629

The "A method for activity-based business modeling for an organization" comprising the steps of:

- (a) receiving a plurality of task entries;
- (b) receiving ...;
- (c) receiving mapping ... ;
- (d) processing ... ;
- (e) generating ... and related to the business model",

as shown are merely an abstract idea and do not produce a useful, tangible, concrete results.

The "A method for activity-based business modeling for an organization" comprising the steps of (a)-(e) as shown are:

- 1) merely an abstract idea and
- 2) does not reduce to a practical application in the technological arts (inclusion of computer/computer automation) and are therefore are found to be non-statutory.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. **Claims 1-6, 7-12, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over MORGAN et al (USP 5,799,286).**

As for independent method¹ claim 1, MORGAN et al fairly teaches a method for activity-based business modeling for an organization comprising the steps of {see col. Line 67 (c1:67 for simplification), c2:1-16, c3:59}:

(a) receiving a plurality of task entries c3:65-c4:2};

(b) receiving a plurality of resource entries, wherein each resource entry indicates any associated personnel, hardware, software (or equipment which normally includes computer, computer system and other IT equipment, see also c4:22 "hardware, software") and services {see c4:1-4};

(c) receiving mapping information showing relationship between the task entries and resource entries {see c4:21-23; "relational database 12" on c2:5-25, c5:65};

(d) processing the plurality of task entries, resource entries and mapping information to formulate a business model {see Fig. 1 (12), c2:62-67};

(e) generating a forward-looking (or forecast) report after (d) and related to the business model" {see c4:5-10, c5:1-6}.

As for the negative limitation of “that does not require historical information from a general ledger” in the preamble, this carries little patentable weight since it does not appear in the body of the claim. Moreover, as shown MORGAN et al c1:37-41, 50-55 or c3:55-60, c4:25-42, the use of the historical information from a general ledger in the modeling process is for the benefit of making result more realistic, reliable or accurate. Note also on c3:55-60 which teaches the option of “may include” general ledger for the benefit above. Therefore, it would have been obvious to avoid the use of the historical information from a general ledger in the modeling process if making result more realistic, reliable or accurate is not critical or important as compared to other criteria such as cost or speed, etc. Furthermore, elimination or removal of an element or step for its intended function in a method is well known practice and would have been obvious to an artisan, absent evidence of unexpected results. See In re Karlson, 136 USPQ 184, 186.

As for dep. claim 2 (part of 1), which deals with well known organization cost/expense parameter, i.e. overhead, this is fairly taught in Fig. 1 (26) or Fig. 16 (280).

As for dep. claim 3 (part of 1), which deals with organization resource parameter, i.e. system, this is fairly taught in Fig. 1 (22) or c4:1-4 (equipment).

As for dep. claim 4 (part of 1), which deals with a source of data entry for an entry above, i.e. from a template, this is non-essential to the scope of the claimed invention and is fairly shown in Fig. 18B. Alternatively, the use of other similar modules (Fig. 1, 18) containing template format would have been obvious as mere using other module format to achieve similar results.

Art Unit: 3629

As for dep. claim 5 (part of 1), which deals with similar limitation as in dep. claim 4 above, it's rejected for the same reason set forth in dep. claim 4 above.

As for dep. claim 6 (part of 1), which deals with well known organization type parameter, i.e. department or whole company, this is fairly taught in c1:56, or c2:40-57.

As for independent method² claim 7, which has similar limitation as in independent method claim 1 (combining receiving steps (a) and (b) into 1 step), it's rejected for the same reason set forth in claim 1 above.

As for dep. claim 8 (part of 7), which deals with well known organization input parameter, i.e. activity entry, this is fairly taught in c4:1-4.

As for dep. claim 9 (part of 7), which deals with well known organization input parameter, i.e. system entry, this is fairly taught in c4:1-4 or c4:22-24.

As for dep. claim 10 (part of 7), which deals additional limitation of "determining a demand" for a specific entry such as system, this is inherently included c4:1-10 wherein a forecast or trend report is determined.

As for dep. claim 11 (part of 7), which deals immaterial modification, type of forecast report, this is inherently included c4:1-10 "value-added report" or would have been obvious to a skilled artisan as mere selection other similar type of report for intended purpose.

As for dep. claim 12 (part of 7), which has similar limitation as in dep. claim 4 above, it's rejected for the same reason set forth in claim 4 above.

As for independent product claim 13 which is the program to carry out the method of independent method claim 1 above, it's rejected over the software of

Art Unit: 3629

MORGAN et al that carrying out the steps of claim 1 above or over the same rejection as shown in claim 1 above.

As for dep. claims 14-18 (part of 13) which have similar limitations as in dep. claims 2-6 (part of 1) respectively, they are rejected for the same reasons set forth in dep. claims 2-6 above.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) US Patent 5,233,513 is cited to teach a business modeling, software, engineering and prototyping method and apparatus.

No claims are allowed.

Art Unit: 3629

8. Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113

Or <http://pair-direct@uspto.gov>.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

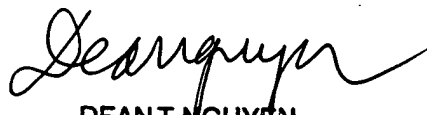
Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053. My work schedule is normally Monday through Friday from 7:00 am through 4:30 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

dtn
February 7, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER